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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 03/06/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/451,160

Examiner

Donald L. Champagne

Applicant(s)

BOAL, STEVEN R.

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4&6-8. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "remote" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the plurality of advertising impressions" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Emaginet.
6. Emaginet teaches an electronic coupon distribution system and method for its operation, the method comprising: collecting user information, comprising demographic characteristics,

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from a user of a client system, without obtaining information sufficient to specifically identify the user; selecting coupons based on the user's demographic characteristics; and transmitting the selected coupons from the main server system to the client system.

7. Emagnet does not teach associating a user ID with the user information at the main server system. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that a user would have to re-register each time he or she visited the site if the user was not given a user ID at the time of their first visit. At very least, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide a user ID at the time of the user's first visit so as to avoid irritating and discouraging users from using the site. Such a user ID would have to be associated with the indicated user information, i.e., the registration information, so as to be useful.
8. Claims 2-6 and 9-23 are rejected under 35 U.S.C. 103(a) as obvious over Emagnet.
9. Emagnet does not teach (claims 2 and 20) that the demographic characteristics include the user's postal zip code or state of residence. Because many products can best be targeted by geographic region (e.g., regional foods or resort services), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include postal zip code or state of residence in the collected demographic characteristics.
10. Emagnet does not teach (claims 3 and 21) associating the user ID with the client system. Official Notice is taken that cookies were well known at the time of the invention. Because cookies are very convenient for the user, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to offer a cookie to the user so as to associate the user ID with the client system, thereby relieving the user of the need to enter the user ID with each visit to the main server system web site.
11. Emagnet does teach (claims 4-6) printing a coupon and that requesting coupon selection from the client is automatic upon accessing the website. As noted in the last paragraph, the user ID is automatically included when cookies are used.
12. Emagnet does teach (claims 9 and 10) a GUI. Emagnet does not teach displaying a flashing icon when a new coupon is available. Because they are both a convenience and a

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reward for users, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to display a flashing icon when a new coupon is available.

13. Emagnet does not teach (claims 11-13, 22 and 23) encrypting or double encrypting the coupons. Because coupons are valuable and encryption discourages theft, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to encrypt or double encrypting the coupons, the double encryption used for the more valuable coupons.
14. Emagnet does teach (claims 14 and 15) transmitting advertising data, because a coupon reads on advertising data.
15. Emagnet does not teach (claims 16-18) storing and encrypting a user detected events history file. Because purchase (detected) events are useful in targeted marketing and because encryption would help protect the user's privacy, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to store and encrypt a user detected events history file.
16. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as obvious over Emagnet in view of Phaal. Emagnet does not teach automatic request transmission at predetermined intervals. Phaal teaches automatic request transmission at predetermined intervals (col. 3 lines 47-55 and col. 12 lines 42-45). Because Phaal teaches that the invention is a low cost mechanism to significantly enhance service (col. 2 lines 44-45), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teaching of Phaal to that of Emagnet.

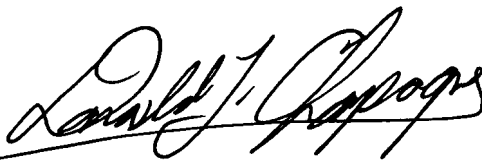
***Allowable Subject Matter***

17. Claims 24 and 25 are allowed.
18. The following is an examiner's statement of reasons for allowance: the closest prior art, Emagnet and the Kepecs US patent, do not teach or suggest disabling access to the URL by the user. Logan et al. teaches preventing access to the URL (web pages) by the user, but the prior art does not suggest combining this reference with either Emagnet or Kepecs.

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**Conclusion**

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 2162

28 February 2002